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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/534,767

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Alain Durr

16528.2a.3a

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09/15/2009

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EXAMINER

KASHNIKOW, ERIK

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

09/15/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/534,767	<b>Applicant(s)</b> DURR, ALAIN	
	<b>Examiner</b> ERIK KASHNIKOW	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/02/09 has been entered.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cavanagh et al. (US 3,955,020).

4. In regards to claim 1 Cavanagh et al. teaches a bottle with a multilayer plastic laminate (column 1 lines 53-67). Cavanagh et al. teach that one of the plastic layers can be of a generally opaque design (Abs) and is made so by adding pigment (Cavanagh column 5 lines 5-15), which would allow one of ordinary skill in the art to adjust the amount of light let through, if any. It is well within the ability of one of ordinary

skill in the art at the time of the invention to adjust the pigment to achieve different levels of light passing through the container. One of ordinary skill in the art would be motivated to do so, based on the end use of the bottle. Examiner also points out that the broadest possible definition of the term “generally opaque” would allow for some light transmittance. Therefore, it is clear that the plastic layers of Cavanagh have limited transparency as presently claimed.

5. Cavanagh et al. also teach that the covering can cover from the bottom of the bottle to the shoulders at the top of the bottle (column 4 lines 54-55).

6. In regards to claim 2 Cavanagh et al. teach that the opaqueness of the bottle can be caused by a coloring material to the one of the plastic layers (claim 4)

7. In regards to claim 3 Cavanagh et al. teach that the layers on the outside of the bottle can be formed from polyethylene, polyvinylchloride, and others (column 4 lines 65-68).

8. In regards to claim 4 Cavanagh et al. show in figure 2 that the plastic layer is laying fully against the container wall.

9. In regards to claim 11 Examiner points out that a vial is defined by dictionary.com as a glass vessel or bottle, especially for use for medicines

(<http://dictionary.reference.com/browse/vial>). As Cavanagh et al. teach that the laminate of their invention is to be used for bottles, one of ordinary skill in the art at the time of the invention would realize that this includes vials.

10. In regards to claim 12 it is well known that medicines can be in liquid form, as such it would be well within the ability of one of ordinary skill in the art to put medicine

Art Unit: 1794

into the bottle of Cavanagh as discussed above. One of ordinary skill in the art at the time of the invention would be motivated to do this to help limit the risk of losing medicine due to inadequate protection of the bottle.

11. While Cavanagh et al are silent regarding the plastic layer covering the entire bottle, they do teach that the plastic layers cover the entire straight portion of the bottle, but that further protection to the heel and shoulders can be added (column 2 lines 49-51). Cavanaugh et al. also teach that the plastic layer can be further combined with plastic caps for the head and heel of the bottle. This embodiment would be obvious to one of ordinary skill in the art as it would offer even more protection to the bottle. It would be well within the ability of one of ordinary skill in the art at the time of the invention to extend the plastic layers to cover these portions of the bottle. One would be motivated to extend the plastic layers to increase the protection offered by the layers.

12. Claims 5, 14, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cavanagh et al. (US 3,955,920) in view of Norwood (US 4,281,520).

13. As stated above Cavanagh et al. teach a multilayer laminate attached to the outside of a bottle. However they are silent regarding the laminate being in the form of half shells.

14. Norwood teaches an apparatus for keeping bottles cool.

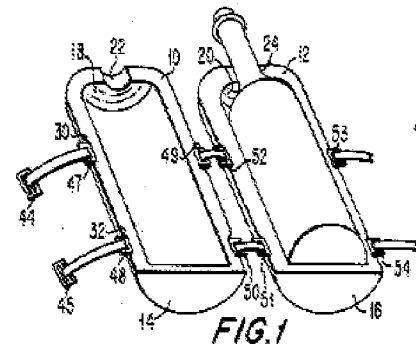
15. In regards to claims 5 and 16 the cooling apparatus of Norwood is a half shell shaped multilayer plastic laminate configured to lie fully against the container wall (Fig. 1).

Art Unit: 1794

16. The limitation for claim 15 and 16 has been discussed in the rejection above.

17. One of ordinary skill in the art at the time of the invention would be motivated to modify the plastic film used to cover bottles of Cavanagh with the half shell shape plastic film design used to cover bottles of Norwood, because the design of Norwood offers the ability to easily use one cover with a broad range of bottle shapes and sizes, as well as introduces the possibility of an easier method of reusing the labels (column 3 lines 20-30).

18. Claim 6-8, 10, 13 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cavanagh et al. (US 3,955,920) in view of Norwood (US 4,281,520) and Witkowski (US 5,525,383).



19. As stated above Cavanagh et al. and Norwood et al. teach a multilayer laminate attached to the outside of a bottle. However they are silent regarding the inclusion of tape to seal the half shells.

20. Witkowski teaches a liquid container (column 2 line 19), with a tubular sleeve mounted on the outside wall of the container (column 2 line 33). Witkowski also teaches that the tubular sleeve can be made of any plastic film (column 4 lines 59-61), and can be transparent or translucent (column 4 line 20-21).

21. In regards to claim 6 and 17 as stated above Witkowski teaches that the sleeve can be formed by a sheet of any plastic material. Witkowski teaches that the sheets are

Art Unit: 1794

formed into a tube (column 5 line 16). Witkowski teaches that the plastic film wrapped around the container can be closed by tape (column 5 line 18).

22. In regards to claim 7, 18 and 19 Witkowski et al teach that the sheet can be printed on while on the container, which would require that the design be

printed onto the tape that is holding the clam shells together (column 4 lines 45-51). It is obvious to one of ordinary skill in the art that if an object can be printed on it may also be written on.

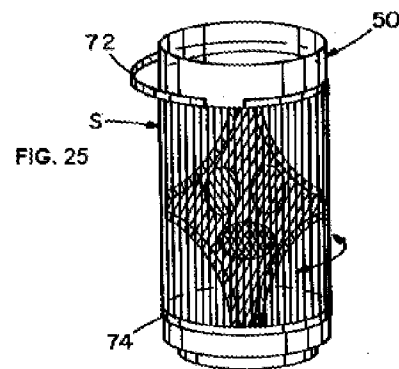
23. In regards to claim 8 Cavanagh et al. teach that the outer layer is attached to the container by use of an adhesive (column 5 line 60 column 6 line 20).

24. In regards to claim 10 Witkowski teaches that the claimed invention can be used to hold different ingredients such as beer or soda (column 1 lines 21-22). Making it so all the containers are identical except for a number or letter on the outer side of the container is just a design choice, and would have been an obvious variant to one of ordinary skill in the art at the time of the invention.

25. Also in regards to claim 10 Cavanagh teaches that the inner lamina **may** be opaque, and is made so by adding pigment (Cavanagh column 5 lines 5-15).

26. In regards to claim 13 Witkowski et al. shows an example in Fig 25, and column 9 lines 25-37 wherein the tape completely encircles the container.

27. It would be obvious to one of ordinary skill in the art at the time of the invention to modify the inventions of Cavanagh and Norwood with the invention of Witkowski



because the invention of Cavanagh and Norwood provides an attractive decoration as well as protection for a wide variety of containers against shattering and scattering of broken glass pieces if the container manages to break (column 1 lines 55-60), while the invention of Witkowski also offers a wide variety of decorating options as well as being inexpensive and durable (column 1 lines 24-28).

### ***Response to Arguments***

28. Applicant's arguments, see arguments, filed 07/02/09, with respect to 35 U.S.C. 112 1<sup>st</sup> paragraph rejections have been fully considered and are persuasive. The 112 1<sup>st</sup> paragraph rejection of the claims has been withdrawn.

29. In regards to Applicant's arguments that Cavanagh et al. do not teach a bottle which has limited transparency, Examiner points out that Cavanaugh et al. use the term "generally opaque" which would allow for some light transmittance. Examiner notes that Applicants have asserted that "generally opaque" is "virtually the same" as opaque, but even virtually the same would leave room for some light transmittance. Examiner also points out that as stated above this opaqueness is acquired by the addition of pigment. It is Examiners opinion that it would be well within the ability of one of ordinary skill in the art to adjust the opaqueness of the cover by adjusting the amount of pigment added to the inner layer.



Art Unit: 1794

In regards to Applicant's arguments regarding the covering of the heel of the container, while Cavanagh et al. do teach the use of transparent materials as protective coatings for the heel of the container Examiner points out that Surlyn® is a preferred material for the covering but is not limited to the only material that may be used to protect the heel. Further, "nonpreferred disclosures can be used. A nonpreferred portion of a reference disclosure is just as significant as the preferred portion in assessing the patentability of claims." In re Nehrenberg, 280 F.2d 161, 126 USPQ 383 (CCPA 1960). Examiner points out that a fair reading of the reference show that Cavanagh et al. teach that the plastic caps are only one option for protecting this portion of the container, but it is not limited to the only option. One of ordinary skill would be motivated to extend the generally opaque lamina to the heel head and shoulders to offer protection against shattering to these areas. One would also be motivated to do this because it would be cost effective by eliminating the need for different types of materials and additional fabrication steps. Applicant has argued that no motivation has been set forth as to why one of ordinary skill in the art would expand the generally opaque lamina to the edges of the container, however Applicant's have not presented any arguments as to why the motivation set forth in the previous office action and again in this action and this paragraph are improper.

30. In response to Applicant's arguments concerning the Norwood reference Examiner notes that regardless of the time and expense, one of ordinary skill in the art at the time of the invention would be motivated to modify the invention of Cavanagh et al. with that of Norwood because the Norwood reference makes it easier to reuse one

Art Unit: 1794

cover on bottles of different size and shape. While the invention of Norwood might make the manufacturing process more involved, it would be economically beneficial in the long run when the sleeves could be used more than once without regards to the bottles shape and size. This is in contrast to Cavanagh wherein one cover after manufacture would not be suitable for bottles of different size and shape. Examiner points out that the invention of Norwood would also be beneficial in preventing scattering of the glass, as the glass would be contained in the enclosure. Further the hinged motion of Norwood would still enable a sleeve to be reused. Applicant has pointed out that the invention of Cavanagh uses an adhesive, and this would teach away from Norwood. However Examiner points out that Cavanagh states that the purpose of the adhesive is to ensure that the label be firmly adhered to the bottle. There is nothing in Cavanagh that says the label may not be firmly adhered and removed at a later date. Further the adhesive while possibly limiting the ability to reuse the label, would still enable a secure connection and would benefit from the ability of Norwood to be used for different shapes and sizes of bottles without having to specifically modify the production process to produce a label for every shape and size of bottle out there, a process that would have vast economic consequences. Examiner notes that Applicant's point out in there response that the invention of Cavanagh could not be used on bottles of different sizes and shapes, which is the motivation presented for combining Cavanagh with Norwood.

31. In response to Applicant's arguments regarding Norwood and Witkowski

Examiner notes that while Norwood and Witkowski does not disclose all the features of

Art Unit: 1794

the present claimed invention, they are used as teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, and in combination with the primary reference, discloses the presently claimed invention. If the secondary reference contained all the features of the present claimed invention, it would be identical to the present claimed invention, and there would be no need for secondary references.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERIK KASHNIKOW whose telephone number is (571)270-3475. The examiner can normally be reached on Monday-Friday 7:30-5:00PM EST (Second Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1794

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Erik Kashnikow  
Examiner  
Art Unit 1794

/Rena L. Dye/  
Supervisory Patent Examiner, Art Unit 1794